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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,650	01/16/2004	James E. Manuel	016295.1559 (DC-05989)	8070

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BAKER BOTTS, LLP
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EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
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3728

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/759,650

Applicant(s)

MANUEL, JAMES E.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-12, 14, 21-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-12, 14, 21-23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 January 2007 has been entered. Claims 1-6, 8-12, 14, 21-23, and 25-29 are pending in the application. Claims 7, 13, 15-20, and 24 have been canceled. Claims 25-29 are new to the application.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. Claims 21-23, 25, 26, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites the "first upper packing support" twice, where a claim directed to a device can be read to include the same element twice, the claim may be indefinite. *Ex parte Kristensen*, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989). To examine the claim

Art Unit: 3728

on its merits, it is presumed that the second occurrence refers to a --first lower packing support--.

Claims 22, 23, 25, 26, and 29 are dependent upon claim 21 and are rejected for the above reasons.

Claim Rejections - 35 USC § 103

4. Claims 1-5, 8-10, 12, 14, 21, and 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Prior Art Figure 1 of the instant application (hereinafter PA1) in view of Chu (US 6,298,989, hereinafter Chu '989).

Claims 1, 8, 21, and 27-29: PA1 discloses the provision of a computer system **9** packaged within a packaging support and shipping container **2**, the packaging support comprising a top section **6** and a bottom section **4**. PA1 does not specifically disclose the specifics of the computer system or the detachable joints.

As to the computer system, Applicant has admitted that the provision of a printed circuit board, processor, memory, and chassis within a computer system was common and conventional and their provision within the computer system **9** of PA1 would have been obvious.

With reference to Figure 1, Chu '989 teaches four tenon **18** and mortise **23** joints for tightly connecting the upper **1** and lower **2** sections of a packing support (see for example Col. 1, lines 55-61) and for said purpose it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the packing

Art Unit: 3728

supports of PA1 with joints as taught by Chu '989. The tenon-mortise joint is an interference fit and functions to operably retain the packaging section as claimed.

Claims 2 and 9: The joints of Chu '989 are reusable.

Claims 3 and 10: PA1 discloses foam material.

Claims 4, 5, 12, and 14 are product-by-process claims. PA1-Chu '989 discloses the claimed structures. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Claim 26: PA1 discloses a C-shape in cross-section.

5. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over PA1-Chu '989 as applied to claims 1 and 8 above, and further in view of Hauss (US 3,511,990; previously provided).

PA1-Chu '989 discloses the claimed invention except for the dovetail joints. Hauss shows that a dovetail joint was an equivalent structure known in the art (see Figures 2 & 3). Therefore, because these two joining means were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute the dovetail joint for the tenon-mortise joint. An express suggestion to substitute one equivalent component or process for another is

Art Unit: 3728

not necessary to render such substitution obvious. *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

6. Claims 21-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chu (US 6,105,765; hereinafter Chu '765) in view of Chu '989.

In Prior Art Figure 6, Chu '765 discloses first upper and first lower packing supports **14** of foam material, second upper and second lower packing supports **12** of foam material, used to package an information handling system with eight corners. Chu '765 merely lacks the detachable joints.

With reference to Figure 1, Chu '989 teaches four tenon **18** and mortise **23** joints for tightly connecting the upper **1** and lower **2** sections of a packing support (see for example Col. 1, lines 55-61) and for said purpose it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first upper and first lower packing supports **14** of Chu '765 with joints as taught by Chu '989, and to provide the second upper and second lower packing supports **12** of Chu '765 with joints as taught by Chu '989.

Response to Arguments


7. Applicant's arguments with respect to claims 1-6, 8-12, 14, 21-23, and 25-29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Greg Pickett
Examiner
3 March 2007